

Notice of Allowability

Application No.

10/790,274

Examiner

Raymond Covington

Applicant(s)

BERKNER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/1/05.
2. ☒ The allowed claim(s) is/are 1-15 and 17-30.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>1/24/06</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

EXAMINER'S AMENDMENT

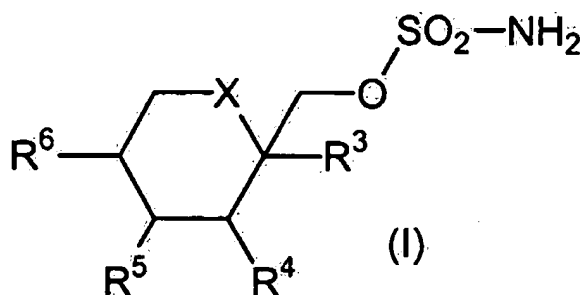
An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mary Appollina on 1/24/06.

The application has been amended as follows:

Claim 1 has been amended in favor of;

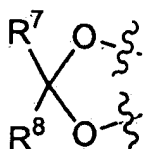
1. (Amended) A process for the preparation of a compound of formula (1)



wherein

X is selected from CH₂ or O;

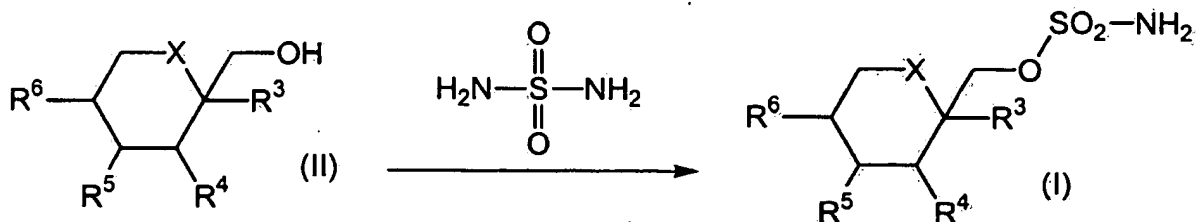
R^3 , R^4 , R^5 and R^6 are each independently selected from hydrogen or lower alkyl and, when X is CH_2 , R^5 and R^6 may be alkene groups joined to form a benzene ring and, when X is O, R^3 and R^4 and/or R^5 and R^6 together may be a methylenedioxy group of the formula:



wherein

R^7 and R^8 are same or different and are hydrogen, lower alkyl or are alkyl and are joined to form a cyclopentyl or cyclohexyl ring;

comprising



reacting a compound of formula (II) with sulfuryl diamide, at an elevated temperature, in the presence of from 0 to about 10% water, to yield the corresponding compound of formula (I).

The amendment removes the R_1 from the formula (I) and claim.

The rejection under 35 USC 102 has been withdrawn as the prior art does not teach compounds produced by the process of claim 1.

In light of applicants' response the rejection under 35 USC 103 has been withdrawn. The prior art neither teaches nor suggests the process, or making products by the process, as presently recited in the claims. Neither Maryanoff et al US 4,582,916 or US 5,387,700 teach reacting applicants' formula (II) with sulfuryl diamide in the presence of 0 to about 10% water to obtain compounds of the formula (I). Patentees teach using substituted alcohol with sulfuryl chloride via the formation of chlorosulfate with amine. The Hatt et al reference teaches a process, which uses sulfuryl diamide, however, it produces a different unrelated product. As such there is no reason to modify Maryanoff et al to obtain the claimed process. Likewise the references Kopec US 3,411,889 and Suzuli et al CA 107:80522 teach also teach sulfuryl diamide and its preparation, however there is not reason to combine these teachings with Maryanoff et al as the results obtained are unsuggested.

Claims 16 and 31-37 have been canceled, without prejudice, as being improper product-by-process claims

Accordingly, claims 1-15 and 17-30 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should

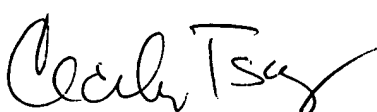
preferably accompany the issue fee. Such submissions should be clearly labeled
“Comments on Statement of Reasons for Allowance.”

Any inquiry concerning this communication or earlier communications from
the examiner should be directed to Raymond Covington whose telephone number
is (571) 272-0681. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner’s supervisor, C. Tsang can be reached on (571) 272-0562. The fax
phone number for the organization where this application or proceeding is assigned
is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR
only. For more information about the PAIR system, see [http://pair-
direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system,
contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RKC


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Technology Center 1600

Raymond Covington
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Art Unit 1625